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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,561	07/07/2003	Winston Richard MacKelvie		5815

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CANADA

EXAMINER

NOVOSAD, JENNIFER ELEANORE

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,561

Applicant(s)

MACKELVIE, WINSTON RICHAR

Examiner

Jennifer E. Novosad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 and 11-17 are, drawn to a hanging file structure and system, respectively, classified in class 211, subclass 46.
- II. Claims 18 and 19, drawn to a hanging file structure, classified in class 211, subclass 46.
- III. Claims 20 and 21, drawn to a hanging file structure, classified in class 211, subclass 46.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as use without sealing the web to the lower edges of the hanger strips and invention II has separate utility such as use without sealing the web to itself. See MPEP § 806.05(d).

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as use without a clip and invention III has separate utility such as use without sealing the web on itself. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

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shown to be separately usable. In the instant case, invention II has separate utility such as use without a clip and invention III has separate utility such as use without sealing the web to the lower edges of the hanger strips. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I (note specifically the aperture) is not required for Groups II and III, the search required for Group II (note specifically the web being sealed to the strips) is not required for Groups I and III, the search required for Group III (note specifically the clips) is not required for Groups I and II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Winston MacKelvie (Applicant) on March 2, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10 and 11-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "E" has been used in both Figure 3 and Figure 7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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The drawings are objected to because numeral 4 has been improperly utilized to depict two different embodiments, i.e., in Figure 13 and 13a. Accordingly, it is suggested that, for example, "4" in Figure 13a, be changed to --4a--. Note that any changes should be incorporated into the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Abstract

The abstract of the disclosure is objected to because of the following informalities:

In line 1, "a" (second occurrence) should be deleted.

In the last line "a" should be changed to --as--.

Correction is required. See MPEP § 608.01(b).

Specification

The disclosure is objected to because of the following informalities:

In line 1 of page 1, --, now abandoned-- should be inserted after "06/21/2002".

In line 14 of page 5, "ot" should be changed to --or--.

Appropriate correction is required.

Claim Objections

Claims 2, 8, 14, and 17 are objected to because of the following informalities:

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In line 3 of claim 2, it appears that "aperture" should be changed to --apertures--, since "a plurality of apertures" has been set forth in line 1 of claim 2.

In claim 8, it is suggested that "said hanger strip" be changed to --each of said hanger strips--.

In line 2 of claim 14, it appears that "portion" should be changed to --portions--.

In line 1 of claim 17, --system-- should be inserted after "file".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 9, and 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 8, 9, and 16, the word "means" is preceded by the word "label" in claims 8 and 16 and no words in claim 9, in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim 11 recites the limitations (a) "the arrangement" in line 10, and (b) "the sealed channels" in line 11. There is insufficient antecedent basis for these limitations in

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the claim. *With respect to (b), to correct this*, it is suggested that --sealed-- be inserted before "channels" in line 5 of claim 11.

The use of the limitation "the flexible nature" in line 13 of claim 11 lacks proper antecedent basis in the claim as well as being vague and/or indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Patterson '402 (U.S. Patent No. 2,948,402).

Patterson '402 discloses a hanging file structure in combination with a container whereby the container has a pair of parallel rails (11) formed from upper side marginal edges of the container and extending between opposed *sides*, i.e., the left front and right rear sides of the perspective view Figure 1 are considered to defines *sides* (it is noted that the container is not described as having side "walls" and thus the structure shown by Patterson is considered to have *sides*); the file structure comprising a continuous (see Figure 4) web (23) of flexible sheet material (24 - see column 2, lines 19-27), i.e., textile material defining a fabric or a plastic sheet, having a pair of opposed side marginal edges; the web (23) being sealed at regular intervals (at 26) therealong to thereby provide a plurality of channels (unnumbered - see Figure 4) extending between the marginal edges and being open at the edges and forming pockets between the sealed channels of the web

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whereby the pockets have a first side wall (at 24 in Figure 3), a second sidewall (opposite the first side wall), and bottom (curved portion between the sidewalls, i.e., near the section 4-4 line at the bottom of Figure 3); a hanger (19) is removably mounted within each of the channels whereby the hanger has end portions extending beyond respective marginal edges of the web; and each of the hangers (19) having a notch (at 22 in Figure 3) formed in an underside of each end which are seated on respective (at 21 in Figure 3) ones of the rails (11). *With respect to claim 11*, Patterson '402 is considered to show the structure capable of performing the step of lifting one of the sidewalls (24) thereby moving the bottom of the web along the other sidewall.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6, 10, 12-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson '402 as applied to claims 1 and 11 above, and further in view of Kroll *et al.* '596 (U.S. Patent No. 4,232,596).

Patterson '402 discloses the structure as advanced above.

The claims differ from Patterson '402 in requiring a plurality of apertures located between portions of the web where it is sealed to itself (claim 2) or an aperture formed in the bottom of each pocket (claim 12).

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Kroll *et al.* '596 teach a structure comprising a flexible web of material (see column 3, lines 13-14) whereby pockets (44) are formed therealong and a plurality of apertures (68) are formed along the web between portions where the web is sealed (by 70 and 76) together and an aperture is formed at the bottom (at 44 in Figure 2) of the pocket.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the web and pockets of Patterson '596 with apertures at the bottom and therealong for increased ease in use by the consumer.

Claims 5, 7, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson '402 in view of Kroll *et al.* 596 as applied to claims 2-4, 6, 10, 12-14, and 17 above, and further in view of Roberg '450 (U.S. Patent No. 4,958,450).

The claims differ from the above references in requiring: (a) the web to be made from a transparent (claims 7 and 15) plastic (claims 5 and 15), and (b) the web to be sealed by heat sealing (claim 9).

With respect to (a) and (b), Roberg '450 teaches that it is old to have a structure to be fabricated from a flexible sheet material defining a transparent plastic (see column 2, lines 36-42) whereby pockets are formed by utilizing heat sealing (at 26 - see column 2, lines 43-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have fabricated the web of Patterson '402 from a transparent plastic, as taught by Roberg '450, so that the web could be sealed by heat sealing thereby easing the economic and manufacturing costs.

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Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson '402 in view of Kroll *et al.* 596 as applied to claims 2-4, 6, 10, 12-14, and 17 above, and further in view of Baumgarten '780 (U.S. Patent No. 5,758,780).

The claims differ from the above references in requiring the hanger to have a label thereon.

Baumgarten '780 discloses a hanging file structure comprising hangers (10) which have a label (at 26) thereon.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the hanging file structure of Patterson '402 with a label on each of the hangers to display information thereon thereby allowing for ease to the consumer.

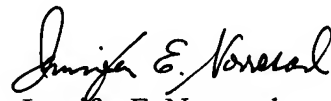
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703)-308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer E. Novosad
Primary Examiner
Art Unit 3634

Jennifer E. Novosad/jen
March 3, 2004